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## **SECOND REPLY BRIEF**

**PATENT APPLICATION 10/805,888**

Filed 3/22/04  
Art Unit 2162

**Robert W. Winter:**

**Searching Content Information Based on  
Standardized Categories and Selectable Categorizers**

Examiner: Dennis Myint

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### **Why a second reply brief is needed**

On May 28, 2009, I was sent a second version of the examiner's answer to my original appeal brief—after I had already filed a reply brief responding to the first version. Although this second version of the examiner's answer contains almost entirely the same language as the first, because of certain additions and deletions, many of the examiner's comments now appear on different page numbers. The primary purpose of my second reply brief is to adjust my own page number references to these modifications in the examiner's answer.

If it is appropriate, I would also like to request a correction to a newly-allowed piece of evidence, my online article entitled "Breaking Through the Walls: Realizing the Internet's Potential, From Politics to the Arts." In the hard copy version attached to the examiner's answer (which is presumably what the people ruling on my appeal will see), at least eleven sections of the article have been omitted, with the result that the article often doesn't flow properly or make much sense. When presented online, the article utilizes a novel exposition structure in which a line of reasoning may break down into multiple sub-sections, these sub-sections may contain sub-sections of their own, etc. Apparently whoever printed the hard copies from the Internet didn't notice more than one level of sub-sections, and that's what has caused the gaps. A better and simpler way to print the article for traditional hard-copy reading is to just print the first page of the article, then press the gold "Continue" button in the lower left-hand corner to bring up the next page in sequence, print that page, and continue on in this manner until the last page of the article has been reached and printed.

### **Why the original reply brief was needed**

In his original answer to my appeal brief, the examiner for the most part recycled the language from his last office action, dated March 3, 2008. His new comments appeared in the Response to Arguments section.

Unfortunately, many of these new remarks misquoted and misconstrued my arguments, and had the net effect of clouding the issues he addressed rather than clarifying them. I filed the original reply brief in an attempt to restore clarity.

### **Errors in representing my appeal argument and prior art**

One misimpression fostered by the examiner's answer occurs in the first paragraph of page 44 of his amended answer document.

These remarks relate to a discussion of a key feature of my invention, the sharing of credit for categorizing content on the Internet and other networks. At issue is whether or not a piece of prior art developed by an inventor named Covington includes a portion of this function.

The examiner begins by misquoting me as saying that “nothing either explicit or implicit in Covington’s description suggests that Database Manager and Database Reviewer might ever make separate categories of a content item.”

Putting aside the matter of omitting the word “the” before “Database Manager,” a more meaningful error in the examiner’s quotation is that my appeal brief actually says that nothing suggests these two types of people might ever make separate *categorizations* of such an item—not categories.

Obviously it would have been nonsensical for me to say that these individuals could turn a content item into a category—or more precisely, multiple categories. But more significantly, substituting the word “categories” introduces a factor of vagueness into the discussion, in which it might well appear to the reader that I could have been talking about categorizing an item in different ways.

In actuality, my statement came in a context where it should be plain from the claim language, as well as from the thrust of the argument in which the statement occurs, that what is being discussed is categorizing the same item *in the same way*. This context is clearly laid out in the preceding paragraph of my appeal (a very short one, consisting of only two sentences), and emphasized again in the sentence that immediately follows the one the examiner has misquoted. (Please see page 29 of my appeal brief, last paragraph.)

After misquoting and thereby misconstruing my argument, the examiner launches into more than a page worth of prior art citations describing Covington’s invention in a way that seems to imply that it involves two people categorizing the same item. But in actuality, the material that the examiner quotes describes only one person, the Database Manager, as categorizing or re-categorizing an item (even in different ways).

I raised this same point in my appeal brief. I’m now at a bit of a loss as to how to clarify the issue more effectively. Is there a good way to establish what a piece of writing does *not* contain? Should I quote each sentence within them separately, parse it all out, and then announce what that sentence does not contain?

I’ll certainly comply with this, if the Patent Office advises that it would be helpful. But at least for now, it seems more reasonable to simply ask the examiner a second time to please give a more careful reading to the material he is citing.

In the interests of further clarifying the issue, if it is felt that the language of my claim does not make it sufficiently plain that the condition being described is one where two people have categorized an item *in the same way*, I would be more than willing to revise the claim language, especially if the Patent Office could offer a bit of guidance in terms of what might constitute acceptable phraseology. (Having seen my former attorney, an educated and experienced professional, repeatedly make errors in phraseology that were rejected by the examiner, as an ordinary layman I am understandably wary of going through an extended process of trial-and-error guesswork, if I am not given at least a small amount of appropriate guidance.)

## **Non-responsiveness to an issue—and to a request for guidance**

So far in my appeal, the examiner has not provided guidance when I have requested it. Of course, as a layman, I having no way of knowing whether this is customary or proper; and it could be that this is simply not the appropriate point in the appeal process for such guidance to be provided. Still, the examiner's comments in the second and third paragraphs of page 46 of his answer document seem notably unhelpful.

In these paragraphs, the examiner responds to my arguments regarding the way a system behavior that I call “quick returns” is defined. Quick returns are, in ordinary English, situations where a user of an Internet search function clicks on a link to an online content item, then comes back almost immediately to the search function, with the speed of the return strongly suggesting that he did not find what he wanted.

In my appeal brief, I agreed with the examiner that the claim language my former attorney originally used (coming back to the search results within “an approximately short time”), as well as what he later substituted (returning within “a substantially short time”), had been vague and indefinite. I mentioned only in passing that I had acquiesced to this language out of a mistaken belief that it had been deemed acceptable in an earlier telephone interview, after which I launched into the main thrust of my argument. The main thrust of my argument included an explanation of the way the function actually works (supported by references to the system specification that served as my preliminary application), and called more specific attention to the fact that the system is designed to apply different standards of quickness in returning to the search function for different categories of content. I pointed out that this means that applying a single numeric standard for quickness of return across all categories, as the examiner had seemed to be insisting on, would not only be unnecessary, it would also contradict the design of my invention. I concluded by suggesting a potential revision to the claim language, and asking for feedback on whether a revision of this type would be acceptable.

The only way in which the examiner's answer addresses this subject is by appearing to scold me for not having challenged my former attorney's verbal description of the phone interview. This is an irrelevant point, since all I was doing in mentioning the historical circumstances was attempting to establish common ground, and demonstrate my own reasonableness and desire to work toward a mutually acceptable understanding. I would never have attempted to claim that an outside party's verbal synopsis of a conversation could somehow have committed the Patent Office to formal legal action.

Meanwhile, the examiner's answer fails to make any mention of my central point, and leaves my request for guidance unanswered.

## **Considering component combinations without regard for motivation**

Elsewhere in his answer document, the examiner responds to my argument that his office actions have not given sufficient consideration to questions of *why* someone would want to combine common components in the way that my invention does. Instead, he responds in a way that, once all the obfuscatory verbiage is peeled away, appears (at least to this layman) to do nothing more than provide another example of the original problem.

Given my lack of legal expertise, I would ask the board's indulgence in allowing me to phrase this issue in a manner that may not be customary, but enables me to state the point in the clearest way I know how.

As I have been given to understand it, the central principle involved here is that it would not normally be possible for me to patent the process of putting ketchup on an Oreo cookie, even if I were the first human to do so (or to describe doing so), because I would not really be teaching anybody anything by it. Anybody who might want to create this rather odd combination would already know how.

However, if by putting ketchup on the cookie I can cure cancer, achieve cold fusion, or accomplish some other useful objective that had not previously been apparent, it is my understanding that I may have grounds for a patent.

My appeal stresses the ways in which my invention utilizes admittedly common components to achieve effects that *could not readily be foreseen*; then challenges the manner in which the examiner seems to have rejected them purely on the basis of inventorying their components and finding these components in use elsewhere.

Responding to my general observation that he has ignored the question of where the motivation to combine ingredients as common as ketchup and Oreos would come from, the examiner gives the following example:

About two-thirds of the way down on page 42, he states that the motivation for combining the selection of a category with the selection of a recommender of content within that category (which he equates to choosing someone who has written a review of the content) would be "to allow selection of reviews by specific reviewers."

How is this any different from saying that the reason for putting ketchup on an Oreo would be to put ketchup on an Oreo?

### **Further confusing tools used with problems solved**

In another section of his answer, the examiner addresses a feature of my invention that anticipates and deals with the likelihood that users will tend to choose content categorizer/recommenders who are well known over those who are not. My reason for including this feature is as follows:

What if a well-known recommender does not actually perform any useful screening of content? The famous person could simply look up the recommendations of a lesser-known individual whose judgments he has learned are astute. He could then make the exact same recommendation as his lesser-known counterpart, and get all the credit (which can have substantial monetary value) when people use his recommendation to find the content item. This "poaching" would siphon away credit and revenue from the lesser-known person who did the real work of rummaging through large quantities of forgettable material to identify the noteworthy item.

As I noted in my appeal brief, such a situation would not only be grossly unfair, it would also undermine the basic viability of the system. If lesser-known recommenders found that famous people were co-opting their revenue streams, they would stop performing the

valuable content screening function on which the system ultimately depends. Since well-known people are unlikely to take the time and trouble to screen vast quantities of marginal material on their own, without the lesser-known recommenders, no one would be left to discover the gems among the rubbish, and the system would no longer have anything useful to offer.

My appeal brief argued that this problem is hardly obvious, and that anticipating it and heading it off via a well-structured system for sharing fees should therefore not be called obvious, either.

More specifically, my appeal contended that a piece of prior art by an inventor named Montemer, which also involves two entities sharing credit for performing a service, does not teach my invention anything significant in dealing with this issue.

The thrust of my argument was that while splitting fees is already such a common business practice as to be the equivalent of using rivets or sheet metal in a mechanical invention, the solution to the problem that my invention uses this technique to accomplish is original—and therefore like getting cold fusion (or some other useful and previously unforeseen effect) from putting ketchup on an Oreo.

In the first paragraph on page 43 of his answer, the examiner responds to my argument that his citations have not taken sufficient account of the reasons why my invention combines common components. Here he states that a person of ordinary skill in the art would have been motivated to add fee sharing in the manner of Montemer to Covington's invention "in order to share resources of categorizers."

In actuality, what the examiner is describing is Montemer's reason for sharing fees. It is not a reason to graft Montemer's practice onto Covington.

The distinction is significant, because it means that the examiner has once again failed to provide a reason why someone would *want* to combine Montemer's invention with Covington's, even in the specific sentence where he claims to have done so.

To cover all possibilities, I will concede that perhaps the reason the examiner failed to articulate his thinking on this point was that he felt it might have been obvious what a person of ordinary skill in the art would hope to achieve by making this combination—i.e., to produce the kind of effect that Montemer does in his own invention, only this time in the context of an invention resembling a hybrid between Covington's and Pundarika's.

To give the examiner additional benefit of the doubt, I will also suppose, for the sake of argument, that such a Covington-Pundarika hybrid might function similarly to mine, at least in certain respects.

However, even after making these presumptions in the examiner's favor, the hypothetical combination of components that the examiner calls obvious *still* turns out to have little relevance to my invention. This is because the problem that Montemer deals with is fundamentally different from the one that my invention solves.

The situation that Montemer's invention utilizes fee sharing to handle involves the absence within a phone company's own local database of an advertiser listing in a category requested by a customer. For example, a customer might have asked for a

breeder specializing in a rare type of dog. Rather than just tell the customer that he can't be helped, Montemer's invention enables the phone company to tap into the database of another local phone company that *does* include breeders of the rare type of dog. The two phone companies then share the service fee for handling the customer's inquiry.

In other words, the purpose of Montemer's fee sharing is to relieve problems of scarcity—i.e., cases where information is lacking.

By contrast, my invention (as elaborated previously) uses fee sharing to resolve problems where categorization/recommendation information is not only *present*, but present from *multiple sources*.

The two conditions are inherently antithetical.

Given the fundamental nature of this difference, how could it be obvious to a person of ordinary skill in the art that Montemer's solution to having too little information would also be effective in dealing with duplicative information? Is fee sharing known to be a technique that cures all categorization- or recommendation-related ills? Could we reasonably expect it to deal with inaccurate categorizations, or poorly considered recommendations? Could it help with the timing of recommendations?

Unless we presume *a priori* that fee sharing can be effective in dealing with virtually any problem (not enough information in Montemer's invention, duplicative information in mine)—in essentially the same credulous manner that the bride's father in the movie *My Big Fat Greek Wedding* ascribes medical benefits to Windex (spraying it indiscriminately on any form of ailment, from rashes to joint pain)—there is no reason to believe that looking to Montemer could teach my invention anything useful about dealing with the “poaching” of recommendations.

Not only is my situation opposite to the one Montemer addresses, Montemer gives no indication of having ever considered my invention's underlying problem—even at the level of duplicative categorizations by ordinary people, before celebrities come into the picture.

When we add the problem of celebrities unfairly exploiting their advantage in name recognition to siphon away earnings from lesser-known recommenders, the notion that Montemer could have somehow taught my invention how to handle the situation becomes even more implausible.

In the final analysis, the differences between Montemer's use of fee sharing and my own invention's techniques do not require deep, subtle, or lengthy analysis to apprehend. Just on its surface, addressing the issue in the simplest and most commonsense terms, would anyone reading Montemer's description of his invention (whether by itself or in combination with Covington's and/or Pundarika's) really be likely to say, “Aha! This is a way to deal with unknown people having their work co-opted by celebrities?”

## Conclusion

The prior art that the examiner has cited in Covington and Montemer does not demonstrate how to solve the otherwise fatal problem of poaching by celebrities that my



invention does. Neither Covington nor Montemer deals with the same situation, or one that is reasonably similar. In fact, neither of these inventions addresses a situation in which two people even make roughly equivalent categorizations or recommendations.

This absence of teachable value in the prior art extends throughout my invention, from the fundamental observations on which it is based to the problems it recognizes, and on into the ways it solves these problems.

During the prosecution process, the examiner has done little more than inventory the components of my invention, find things similar to them scattered among various other inventions, and pronounce my invention obvious because of the components' pre-existence. When my appeal brief pointed out his lack of consideration for the issue of *why* someone would choose to combine these components, the examiner's attempts to provide reasons have amounted to little more than saying that someone would want to combine the components in order to combine the components.

My contention is that the mere use of pre-existing components should not, in and of itself, render an invention obvious. This contention is based on the difficulty of providing a logical justification for a hard-and-fast rule rendering inventions that utilize pre-existing components automatically obvious.

What would such a justification consist of? Are we simply to presume that if components exist, they will eventually be combined—even if for no apparent reason—until finally, by some fortunate accident, a combination occurs that only coincidentally manages to achieve a roughly similar beneficial effect? This type of thinking is similar to believing that a roomful of monkeys with typewriters will eventually crank out a Shakespearean sonnet.

It is not an approach on which a viable, innovation-conducive system of intellectual property rights can be based.

I submit that the non-obviousness of the way in which an invention *solves a problem* should also be a factor in assessing novelty.

I further submit that when viewed through this latter lens, my invention satisfies the requirement for novelty—based on a range of previously unseen solutions to problems, from the overall functional capability the invention provides (enabling the Internet to finally supersede many existing media companies) down through more detailed, tactical-level innovations like preventing celebrity “poaching” of content recommendations from deterring ordinary people from making their own recommendations.